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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,774	11/05/2001	Shigenori Morikawa	01711/LH	5900
1933 7590 12/20/2007 FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 Fifth Avenue 16TH Floor NEW YORK, NY 10001-7708			EXAMINER WONG, BLANCHE	
			ART UNIT 2619	PAPER NUMBER
			MAIL DATE 12/20/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/991,774

Applicant(s)

MORIKAWA, SHIGENORI

Examiner

Blanche Wong

Art Unit

2619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 November 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed October 1, 2007 have been fully considered but they are not persuasive.
2. With regard to new claims 14,20,22,23, Applicant states that "upon receiving a set of data of unknown data size or whose data amount cannot be recognized until it is received, for example, the claimed present invention measures the data amount 'while receiving' the set of objective data to be transmitted/received and warns a user when the data amount has reached a predetermined data amount ... and if the data is unnecessary or not of sufficient value the user can terminate data communication ... a large amount of unnecessary data is not transmitted or received at a high communication charge, ... even without being aware of the charging system of the connected communication network, the user can prevent the communication charge for a set of objective data to be transmitted or received from exceeding an upper limit of the communication charge." Amendment, p.12, para. 2 – p.13, para. 1. However, Examiner respectfully disagrees.
3. If Applicant is arguing a set of data of unknown data size or whose data amount cannot be recognized until it is received, such a limitation is not found in the claims.
4. If Applicant is arguing "while receiving", such a limitation is not found in the claims.
5. If Applicant is arguing a high communication charge, such a limitation is not found in the claims.

6. If the Applicant is arguing data that is unnecessary or not of sufficient value [to the user], such a limitation is not found in the claims.
7. If Applicant is arguing charging system, such a limitation is not found in the claims.
8. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., set of data of unknown data size or whose data amount cannot be recognized until it is received, "while receiving", a high communication charge, data that is unnecessary or not of sufficient value [to the user], charging system) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
9. Furthermore, Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.
10. With regard to new claims 14,20,22,23, Applicant states that "... even without being aware of the charging system of the connected communication network, the user can prevent the communication charge for a set of objective data to be transmitted or received from exceeding an upper limit of the communication charge." Amendment, p.13, para. 1. However, Examiner respectfully disagrees.

11. In response to applicant's argument that the user can prevent the communication charge for a set of objective data to be transmitted or received from exceeding an upper limit of the communication charge, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

### ***Drawings***

12. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the means for recognizing a start and an end of transmission/reception of a set of objective data to be transmitted/received, means for measuring a transmitted/received data amount, means for judging whether the [measured] transmitted/received data amount ... has reached a data amount specified for the set of objective data, means for ... warning a user that the transmitted/received data amount has reached the specified data amount, means for ... temporarily suspending ... receiving from the user an instruction ... and resuming or terminating transmission/reception (claim 14); and a first and second data communication means, a first and second calculating means (claim 20) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

For example, Specification, p.8, line 21, discloses a start date information 22G and end date information 22H. However, claim language recites a start and an end of transmission/reception of a set of objective data.

### ***Specification***

13. The abstract of the disclosure is objected to because it does not enable a quick determination "from a cursory inspection the nature and gist of the technical disclosure". For example, accounting, the start and end of transmission/reception, warning money amount, are not found in the Specification nor claims. Correction is required. See MPEP § 608.01(b).

### ***Claim Objections***

14. Claims 14,16-18,20,21 are objected to because of the following informalities:

With regard to claim 14, Examiner suggests replacing "the transmitted/received data amount measured by the measuring means" in lines 11-12 with "the measured transmitted/received data amount" or the transmitted/received data amount measured" for simplicity because it is clear that the judging means judges the output of the measuring means.

With regard to claim 14, Examiner suggests replacing "it is judged by the judging means" in lines 14 and 19 with "the judging means judges" to put the claim limitation in active voice.

With regard to claim 16, Examiner suggests replacing "an upper limit value of the data amount with which the set of objective data to be transmitted/received can be transmitted/received continuously" in lines 2-4 with "an upper limit value of the transmitted/received data amount" for clarity.

With regard to claim 17, Examiner suggests replacing "the data amount with which the set of objective data to be transmitted/received continuously" in lines 5-6 with "the transmitted/received data amount" for clarity.

With regard to claim 18, Examiner suggests replacing "the communication charge calculated by the calculating means" in lines 9-10 with "the communication charge" because it is clear that from line 3 what is the communication charge.

With regard to claim 20, Examiner suggests replacing "it is judged by the judging means" in line 28 with "the judging means judges" to put the claim limitation in active voice.

With regard to claim 21, Examiner suggests replacing "the communication charge calculated by the judging means" in line 2 with "the calculated communication charge" in consistent with "the calculated communication charge" in claim 20, line 26.

With regard to claim 21, Examiner suggests replacing "the limit amount communication charge" in line 3 with "the communication charge limit amount" in consistent with "the communication charge limit amount" in claim 20, lines 26-27.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

15. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

16. **Claims 14-23** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

For example, with regard to claim 14, Specification, p.8, line 21, discloses a start date information 22G and end date information 22H. However, claim 14 recites a start and an end of transmission/reception of a set of objective data.

With regard to claim 20, Specification does not disclose a first and second data communication means. However, claim 20 recites a first and second data communication means.

With regard to claims 22 and 23, Specification does not disclose a computer-readable recording medium having stored thereon a program that performs the functions in claims 22 and 23.

17. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

18. **Claims 14-19,22,23** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 14, it is unclear what is "a set of objective data" in line 6.



With regard to claim 14, it is unclear whether the judging means in lines 14 and 19 judges the transmitted/received data amount or the *measured* transmitted/received data amount (with emphasis).

With regard to claim 15, it is unclear whether "an instruction from the user" in line 4 is the same as "the received instruction" in claim 14, line 26.

With regard to claim 16, it is unclear whether "an upper limit value of the data amount" in lines 2-3 is the upper limit value of the transmitted/received data amount in claim 14, line 8.

With regard to claim 17, it is unclear whether "transmission/reception of data" in line 2 is the "transmission/reception of the set of objective data" as in claim 14, line 25.

With regard to claim 17, it is unclear what is meant by "the data amount with which the set of objective data to be transmitted/received" in lines 5-6.

With regard to claim 19, it is unclear whether the communication charge is calculated "according to the transmitted/received data amount" in line 5 or "based on the set communication charge per unit data amount" in line 6.

With regard to claims 22 and 23, it is unclear whether it is a method or apparatus claim and whether the computer-readable recording medium or the program is carrying out functions.

19. There is insufficient antecedent basis for this limitation in the claim.

Claim 16, lines 7-8, "the data amount specified for the set of objective data".

***Claim Rejections - 35 USC § 103***

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. **Claims 14 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al. (U.S. Pat No. 5,539,747) in view of Dacloush et al. (U.S. Pat No. 6,700,961)

With regard to claims 14 and 20, Ito discloses

means for recognizing a start and an end of transmission/reception (**each user device has a counter called a window counter**", col. 7, lines 1-2) of a set of objective data to be transmitted/received ("**... each of [user devices] communications with other user devices ... transmitting to/receiving from cells**", col. 6, line 64-col. 7, line 1);

means for measuring (**window counter**) a transmitted/received data amount from the start to the end of transmission/reception of the set of objective data;

means for judging (**cell loss possibility judging unit 120 in Fig. 1, col. 7, line 66**) whether or not the measured transmitted/received data amount has reached a data amount specified for the set of objective data;

means for (**cell loss possibility judging unit**), when the judging means judges that the measured transmitted/received data amount has reached the data amount

specified for the set of objective data, warning a user that the transmitted/received data amount has reached the specified data amount (**"The cell loss possibility judging unit 120 judges as for each of the output buffers if cell abandonment is likely to occur (overflow). Subsequently, if the cell loss possibility judging unit judges that an output buffer is likely to abandon cells, it notifies the traffic controller ...", col. 8, lines 10-12).**

Ito does not disclose means for, when the judging means judges that the measured transmitted/received data amount has reached the data amount specified for the set of objective data, temporarily suspending transmission/reception of the set of objective data, receiving from the user an instruction to resume or terminate the transmission/reception of the set of objective data, and resuming or terminating transmission/reception of the set of objective data in accordance with the received instruction.

Dacloush discloses

means for **(timer)(a timer is started for a period of time equal to or somewhat shorter than the maximum calculated time, col. 4, line 6),** when the judging means judges that the measured transmitted/received data amount has reached the data amount specified for the set of objective data **(when a time out is detected, col. 4, line 26),** temporarily suspending **(on hold, col. 4, line 31)** transmission/reception of the set of objective data, receiving from the user an instruction **(a response from the call originator)** to resume or terminate connection from a user **(the tone or announcement calls for a response from the call originator to provide**

**new prepayment value against which future parts of the connection may be charged, col. 4, lines 32-35), and resuming or terminating (call is terminated [at the end of the timer period]) transmission/reception of the set of objective data in accordance with the received instruction (times out) (when the call originator does not respond to the tone ... the timer times out and the call is terminated, col. 4, lines 54-60).**

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine means for, when the judging means judges that the measured transmitted/received data amount has reached the data amount specified for the set of objective data, temporarily suspending transmission/reception of the set of objective data, receiving from the user an instruction to resume or terminate the transmission/reception of the set of objective data, and resuming or terminating transmission/reception of the set of objective data in accordance with the received instruction, as taught in Dacloush, with Ito, to provide for a system that is user friendly.

***Allowable Subject Matter***

22. Claim 20 and 23 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.
23. Claim 21 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

**Conclusion**

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blanche Wong whose telephone number is 571-272-3177. The examiner can normally be reached on Monday through Friday, 830am to 530pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edan Orgad can be reached on 571-272-7884. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*BW*

BW  
December 16, 2007

EDAN . ORGAD  
SUPERVISORY PATENT EXAMINER

*Edan Orgad*